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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TOM REN and YING XIONG

Appeal 2008-1326
Application 09/834,701
Technology Center 2100

Decided: November 14, 2008

Before JOSEPH L. DIXON, JAY P. LUCAS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134(a) from the Examiner's rejection of claims 1-12, 17, and 19-28. Claims 13-16 and 18 are cancelled. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm. We also enter new grounds of rejection against claims 1-12, 17, and 19-28 under the provisions of 37 C.F.R. § 41.50(b).

THE INVENTION

The disclosed invention relates generally to a web-based database. More particularly, the invention relates the automatic population of a database, automatic notification to the individual account members of the database, and automatic maintenance of the database. (Spec. 1, Para. 2).

Independent claim 1 is illustrative:

1. A method of automatically populating, maintaining and updating a web-based database, the method comprising the steps of:
 - (a) transferring multiple records of individuals from an existing database to the web-based database automatically and without express registration action in the web-based database;
 - (b) populating a web-based database with the multiple records of the individuals from the existing database without express registration action in the web-based database;
 - (c) creating access accounts for the multiple individuals without express registration action in the web-based database by the individuals;
 - (d) transmitting at least one access account to at least one of the multiple individuals; and
 - (e) enabling remote maintenance of the individual records by the individuals by use of the access account.

THE REFERENCES

The Examiner relies upon the following references as evidence in support of the rejections:

Champagne	US 6,925,477 B1	Aug. 2, 2005 (filed Mar. 31, 1998)
Dean	US 6,182,131 B1	Jan. 30, 2001 (filed Jul. 17, 1998)
Weinreich	US 6,175,831 B1	Jan. 16, 2001 (filed Jan. 17, 1997)
Ramasubramani	US 6,233,577 B1	May 15, 2001 (filed Feb. 17, 1998)
Lee	US 6,108,691	Aug. 22, 2000 (filed Apr. 17, 1998)
Ram	US 6,625,258 B1	Sep. 23, 2003 (filed Dec. 27, 1999)

THE REJECTIONS

1. Claims 1-4, 6, 7, 9, 11, 12, 17, and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich.
2. Claims 24, 25, 27, and 28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich and Ramasubramani.
3. Claim 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich and Champagne.
4. Claims 8, 10, 20, 22, and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich and Ram.

5. Claim 26 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich and Ramasubramani and Ram.
6. Claim 19 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Dean in view of Weinreich and Lee.

APPELLANTS' CONTENTIONS

1. Appellants contend that the Examiner failed to provide a teaching or motivation to combine Dean with Weinreich. (App. Br. 20). In addition, Appellants contend that Dean and Weinreich teach away from their combination, and the proposed modification renders the references unsatisfactory for their intended purpose. (App. Br. 25)
2. Appellants contend that the Examiner erred in rejecting claims 1-4, 6, 7, 9, 11, 12, 17, and 21 because the cited references and the present invention are significantly different and teach away from each other. (App. Br. 27-31).
3. Appellants contend that the Examiner erred in rejecting claims 24, 25, 27, and 28 because one skilled in the art would not be motivated to combine the teachings of Ramasubramani with Dean/Weinreich. (App. Br. 34).

4. Appellants contend that the Examiner erred in rejecting claim 5 because the rejection is a result of piecemeal analysis. (App. Br. 37).
5. Appellants contend that the Examiner erred in rejecting claims 8, 10, 20, 22, 23, and 26 because the Examiner has not shown how the cited references are combined. (App. Br. 38-39).
6. Appellants contend that the Examiner erred in rejecting claim 19 because the rejection is a result of piecemeal analysis. (App. Br. 39-40).

EXAMINER'S FINDINGS

1. The Examiner determined that the present application is related to transferring multiple records of individuals from an existing database to the web-based database automatically and automatically populating and maintaining a web-based database. (Ans. 22)
2. The Examiner determined that Dean is directed to transmitting account information including a plurality of usernames in each user account 32 of account registry 30 from LAN 10 to account manager 38. The Account manager 38 utilizes the received account information to automatically create individual user accounts. (Ans. 22-23).

3. The Examiner determined that Weinreich provides user profiles (accounts) in a network database and uses a network database to perform a search for information about a registered user. (Ans. 23)
4. The Examiner determined that Dean, Weinreich and Ramasubramani are related to the same fields of storing user accounts or user records or user profiles on a database. (Ans. 38)

ISSUES

1. Did the Appellants show that the Examiner failed to establish that one skilled in the art would combine the teachings of the cited references?
2. Did the Appellants show that the Examiner erred in combining Dean and Weinreich because the cited references teach away from each other?
3. Did the Appellants show that the Examiner erred in combining Dean, Weinreich and Ram?
4. Did the Appellants show that the Examiner erred in combining Dean, Weinreich and Ramasubramani?

PRINCIPLES OF LAW

Obviousness

In rejecting claims under 35 U.S.C. § 103, “[w]hat matters is the objective reach of the claim. If the claim extends to what is obvious, it is

invalid under § 103.” *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1742 (2007). To be nonobvious, an improvement must be “more than the predictable use of prior art elements according to their established functions.” *Id.* at 1740.

The reasoning given as support for the conclusion of obviousness can be based on “interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art.” *KSR*, 127 S. Ct. at 1740-41.

We note our reviewing court has recently reaffirmed that:

[A]n implicit motivation to combine exists not only when a suggestion may be gleaned from the prior art as a whole, but when the ‘improvement’ is technology-independent and the combination of references results in a product or process that is more desirable, for example because it is stronger, cheaper, cleaner, faster, lighter, smaller, more durable, or more efficient. Because the desire to enhance commercial opportunities by improving a product or process is universal-and even common-sensical-we have held that there exists in these situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him *capable* of combining the prior art references.

Dystar Textilfarben GmbH v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006). *See also Leapfrog Enters., Inc. v. Fisher-Price Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007)(holding it “obvious to combine the Bevan device with the SSR to update it using modern electronic components in

order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost.”)

“[T]he prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed ...” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004) (underline added).

Appellants have the burden on appeal to the Board to demonstrate error in the Examiner’s position. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006). Therefore, we look to Appellants’ Briefs to show error in the proffered *prima facie* case.

We note that arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006). *See also In re Watts*, 354 F.3d 1362, 1368 (Fed. Cir. 2004).

Findings of Facts

The following findings of fact are supported by a preponderance of the evidence.

Dean

1. Dean is directed to automating the creation of accounts in a network. (Abst., ll. 1-2).
2. Dean teaches transmitting extracted account information from the LAN 10 to account manager 38 in ISP 22. (Col. 3, ll. 30-32)

3. Dean teaches that the extracted account information is utilized to automatically create accounts for the selected users. (Col. 3, ll. 26-29) (underline added).

Weinreich

4. Weinreich is directed to a networking database in which the individual records that are connected by defined relationships. (Abst., ll. 1-3)
5. Weinreich teaches allowing a user to edit or delete their information in a web-based database. (Col. 18, ll. 25-27 and 43-55).
6. Weinreich teaches that the database server 45 updates the database 70 to edit information teaches an access right control unit. The access right control unit checks the access right on the file and the link provided to the user and changes the status of the access right if necessary. (Col. 4, ll. 32-38).

Ramasubramani

7. Ramasubramani is directed to a central certificate management system for thin client devices in data networks. (Abst., ll. 1-2).

Champagne

8. Champagne is directed to transferring records between two databases. (Abst., ll. 1-2)

9. Champagne teaches that a computer program automatically establishes a field map between the record structures of the two databases. (Id.)

Ram

10. Ram is directed to a unified communication services support via a virtual assistant system (VAS). (Abst., ll. 1-2).

Specification

11. The Specification is silent with regards to the limitation of “without express registration.”

ANALYSIS

The Examiner failed to provide a teaching or motivation to combine the cited references, the cited references teach away from their combination.

Appellants contend that for all claims the Examiner failed to provide a teaching or motivation to combine *from the references*. (App. Br. 20) (emphasis added).

As discussed above, the motivation to combine two or more references may stem not only from the references themselves, but also from “the background knowledge possessed by a person having ordinary skill in the art.” KSR, 127 S. Ct. at 1740-41 (emphasis added). Thus, the only source of motivation to combine the teachings of references does not have to be provided by the references themselves.

In the present case, as admitted by Appellants, the Examiner provided a motivation to combine the teachings of Dean and Weinreich. (App. Br. 21-22). However, we further note that Appellants' have also argued how the cited references differ from the present invention, rather than why the two references are not combinable. With regards to Appellants' contention that the cited references teach away from each other, we disagree.

In the present case, we do not find and Appellants have not shown, that either of Dean or Weinreich expressly teaches away from a combination with the other, because neither of the references criticizes, discredits or discourages the proposed combination. *See In re Fulton*, 391 F.3d at 1201. Thus, we do not find Appellants' argument that the cited references teach away from each other to be persuasive.

Based on the above, we do not find Appellants' arguments to be persuasive in proving error in the Examiner's cited combination of references.

Claims 1-4, 6, 7, 9, 11, 12, 17, and 21

The Examiner erred in rejecting claims 1-4, 6, 7, 9, 11, 12, 17, and 21 because the cited references and the present invention are significantly different and teach away from each other.

We next consider the Examiner's rejection of claims 1-4, 6, 7, 9, 11, 12, 17, and 21 as being unpatentable over Dean and Weinreich. Since Appellants' arguments have treated these claims as a single group which stand or fall together, we select independent claim 1 as the representative claim for this rejection. *See 37 C.F.R. § 41.37(c)(1)(vii)(2006).*

Appellants contend that the Examiner erred in rejecting claims 1-4, 6, 7, 9, 11, 12, 17, and 21 because the cited references and the present invention are significantly different, and teach away from each other. (App. Br. 27-31). More specifically, Appellants contend that neither of the references teaches or suggests performing the steps of claim 1 “automatically” and “without express registration” in the web-based database.

Claim Construction

During prosecution, “the PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

We note that the feature of performing the steps of claim 1 “without express registration” is interpreted as a negative limitation.

We find that Appellants’ Specification does not expressly support the feature of “without express registration.”

Silence in the Specification does not meet the written description requirement for a negative limitation. The Court of Appeals for the Federal Circuit has determined that an express intent to confer on the claim language the novel meaning imparted by the negative limitation is required, such as an express disclaimer or independent lexicography in the written description that provides support for the negative limitation. *Omega Engineering, Inc, v. Raytek Corp.*, 334 F.3d 1314, 1323 (Fed. Cir. 2003) (citations omitted).

Beyond the words of the claim, neither the district court nor Raytek has identified any express disclaimer or independent lexicography in the written description that would justify adding that negative limitation. *See CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366-67, 62 USPQ2d 1658, 1662-63 (Fed.Cir.2002). Our independent review of the patent document, *see Bell Atl. Network Servs., Inc. v. Covad Communications Group, Inc.*, 262 F.3d 1258, 1266, 59 USPQ2d 1865, 1869 (Fed.Cir.2001), reveals no express intent to confer on the claim language the novel meaning imparted by this negative limitation. Accordingly, we must conclude that there is no basis in the patent specification for adding the negative limitation.

In the present case, Appellants cite Fig. 4 and page 6, l. 26 – page 7 l. 16 in the “Summary of the Claimed Subject Matter” section, for support of the negative limitation. (App. Br. 11). However, our review of Appellants’ Specification does not reveal any express support for the negative limitation argued by Appellants. Therefore, we find no basis or express intent in the Specification that supports the negative limitation, and we do not know how to interpret it. (See “New Grounds of Rejection” *infra*).

Because Appellants’ arguments regarding the difference between the cited references and the present invention are based on the unsupported negative limitation, we do not find Appellants’ arguments to be persuasive. Accordingly, we conclude that Appellants’ have not shown error in the Examiner’s rejection of claim 1 and claims 2-4, 6, 7, 9, 11, 12, 17, and 21 which fall therewith, as being obvious over the cited references.

Claims 24, 25, 27, and 28

The Examiner erred in rejecting claims 24, 25, 27 and 28 because one skilled in the art would not be motivated to combine the teachings of Ramasubramani with Dean/Weinreich.

We next consider the Examiner's rejection of claims 24, 25, 27, and 28 as being unpatentable over Dean, in view of Weinreich and Ramasubramani. Appellants contend that the Examiner erred in rejecting claims 24-25, 27 and 28 because one skilled in the art would not have been motivated to combine the teachings of Ramasubramani with Dean/Weinreich. (App. Br. 34-35). Since Appellants' arguments have treated these claims as a single group which stand or fall together, we select independent claim 24 as the representative claim for this rejection. See 37 C.F.R. § 41.37(c)(1)(vii)(2006).

As discussed above, to be nonobvious, an improvement must be "more than the predictable use of prior art elements according to their established functions."

In the present case, we do not find, nor have Appellants shown, that the cited combination of references is more than a predictable use of prior art elements according to their established functions. Thus, Appellants' argument that a greater explanation of Ramasubramani should be required is not persuasive. Therefore, we find that the Examiner provided a proper motivation to combine the teachings of the references. Accordingly, we sustain the Examiner's rejection of claim 24 and claims 25, 27, and 28 which fall therewith as being unpatentable over Dean, in view of Weinreich and Ramasubramani.

Claim 5

The rejection of claim 5 is the result of piecemeal analysis.

We next consider the Examiner's rejection of claim 5 as being unpatentable over Dean, in view of Weinreich and Champagne. Appellants contend that the rejection of claim 5 is the result of piecemeal analysis. The Examiner relied on Champagne to teach the limitation recited in claim 5. (Ans. 17).

We also note that Appellants admit that the elements recited in dependent claim 5 are well-known in the art. (App. Br. 37 citing Para. 24 of the Spec.).

Having acknowledged that certain claimed elements are taught by the prior art, Appellants cannot now defeat an obviousness rejection by asserting that the cited references fail to teach or suggest these elements. *See Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 1570 (Fed. Cir. 1988) (“A statement in a patent that something is in the prior art is binding on the applicant and patentee for determinations of anticipation and obviousness.”); *In re Nomiya*, 509 F.2d 566, 571 n.5 (CCPA 1975) (It is a “basic proposition that a statement by an applicant, whether in the application or in other papers submitted during prosecution, that certain matter is ‘prior art’ to him, is an admission that that matter is prior art for all purposes . . .”).

Thus, based on the administrative record before us including the discussion above regarding claim 1 from which claim 5 depends and Appellants' admission, we conclude that Appellants' have not shown that the Examiner erred in rejecting claim 5. Accordingly, we sustain the

Examiner's rejection of claim 5 as unpatentable over Dean, in view of Weinreich and Champagne.

Claims 8, 10, 20, 22, 23, and 26

The Examiner has not shown how the cited references are combined.

We next consider the Examiner's rejection of claim 8, 10, 20, 22, 23 and 26 as being unpatentable over Dean, in view of Weinreich and Ram. Since Appellants' arguments have treated these claims as a single group which stand or fall together, we will select independent claim 8 as the representative claim for this rejection. *See* 37 C.F.R. § 41.37(c)(1)(vii)(2006).

Appellants contend that the Examiner erred in rejecting claim 8 because the Examiner failed to establish how the cited references are combined.

It is our view that Appellants' arguments do not take into account what the collective teachings of the prior art would have suggested to one of ordinary skill in the art and is therefore ineffective to rebut the Examiner's *prima facie* case of obviousness. *See In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art.) (citations omitted, emphasis added). *Keller*, 642 F.2d at 425.

This reasoning is applicable in the present case. For example, Appellants contend that “Ram does not permit modification of account characteristics through a web portal to a specific web page to modify rate plans and the like . . .” However, Appellants have not shown error in the Examiner’s determination that the teachings of Ram would result in a reduced routing cost for sending access accounts or any other type of information to users. (Ans. 42). Thus, Appellants’ arguments are not found to be persuasive. Accordingly, we sustain the Examiner’s rejection of claim 8 and claims 10, 20, 22, 23, and 26 which fall therewith, as being unpatentable over Dean, in view of Weinreich and Ram.

Claim 19

The rejection of claim 19 is the result of piecemeal analysis

Appellants contend that the Examiner erred in rejecting claim 19 because the rejection is a result of piecemeal analysis. More specifically, Appellants contend that the Examiner’s citation of Lee indicates an “impermissible picking and choosing” of features to establish obviousness.

However, similar to our discussion above, without more, Appellants have not shown how the cited combination of references would result in more than an expected result. Thus, we conclude that Appellants have not shown error in the Examiner’s rejection of claim 19. Accordingly, we sustain the rejection of claim 19 as being unpatentable over Dean, in view of Weinreich and Lee.

NEW GROUNDS OF REJECTION

35 U.S.C. § 112, first paragraph

Using our authority under 37 C.F.R. § 41.50(b), we reject independent claims 1-12, 17, and 19-28 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. *See, e.g., Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555 1563. However, a showing of possession alone does not cure the lack of a written description. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 323 F.3d 956, 969 (Fed. Cir. 2002). Much of the written description case law addresses whether the specification as originally filed supports claims not originally in the application.

The independent claims 1, 17 and 24 recite “. . . without express registration action . . .”. Appellants’ Specification does not expressly support this negative limitation. As a result, the Specification does not describe the claimed invention in sufficient detail that one skilled in the art would have reasonably concluded that the Appellants had possession of the claimed invention.

Accordingly, we reject independent claims 1, 17, and 24 as well as dependent claims 2-12, 19-23, and 25-28 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

CONCLUSIONS OF LAW

Based on the findings of facts and analysis above, we conclude the following:

Appellants did not show that the Examiner failed to establish that one skilled in the art would combine the teachings of the cited references.

Appellants did not show that the Examiner erred in combining Dean and Weinreich because the cited references teach away from each other.

Appellants did not show that the Examiner erred in combining Dean, Weinreich and Ram. Appellants did not show that the Examiner erred in combining Dean, Weinreich, Ramasubramani and Ram.

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 1-4, 6, 7, 9, 11, 12, 17, and 21 as being unpatentable over Dean in view of Weinreich under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 24, 25, 27, and 28 as being unpatentable over Dean in view of Weinreich and Ramasubramani under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claim 5 as being unpatentable over Dean in view of Weinreich and Champagne under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claims 8, 10, 20, 22, and 23 as being unpatentable over Dean in view of Weinreich and Ram under 35 U.S.C. § 103(a).

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claim 26 as being unpatentable over Dean in view of Weinreich Ramasubramani and Ram.

Based on the findings of facts and analysis above, we conclude that Appellants have not met their burden of showing that the Examiner erred in rejecting claim 19 as being unpatentable over Dean in view of Weinreich and Lee.

Therefore, claims 1-12, 17, and 19-28 are not patentable.

DECISION

The decision of the Examiner rejecting claims 1-12, 17, and 19-28 is affirmed.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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